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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,786	09/04/2003	David L. Kaminsky	RSW920030125US1	5510

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A. Bruce Clay
IBM Corporation T81/503
PO Box 12195
Research Triangle Park, NC 27709

EXAMINER
BATES, KEVIN T

ART UNIT	PAPER NUMBER
2155	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 March 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

This Office Action is in response to a communication made on September 4,

2003.

Claims 1-27 are pending in this application.

Claim Objections

Claims 25 and 26 are objected to because of the following informalities: The

have the limitation "computer-usable media" while the specification defines computer-

readable storage media. In order to have antecedent support from the specification, the

claimed limitation must be changed to that which is defined in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-17, 19-22, and 24-27 are rejected under 35 U.S.C. 102(a) as being

anticipated by Brown (2003/0055908).

Regarding claims 1, 20, 24, 25, 26, and 27, Brown teaches a method of

enabling an instant messaging ("IM") user to specify policy information usable in

responding to arrival of instant messages (Paragraph 42), comprising steps of:

defining, by the IM user, policy information specifying criteria for responding to

arrival of instant messages (Paragraph 55); and

using the defined policy information, upon arrival of an instant message from an

IM sender not already participating in an IM session with the IM user, to

programmatically determine a response to the arriving instant message (Paragraph 60;

67).

Regarding claim 2, Brown teaches the method according to claim 1, wherein the

policy information identifies a particular IM sender (Paragraph 65; 76).

Regarding claim 3, Brown teaches the method according to claim 1, wherein the

policy information identifies characteristics of IM senders (Paragraph 55; 65).

Regarding claim 4, Brown teaches the method according to claim 1, wherein the

policy information specifies static criteria (Paragraph 74-77).

Regarding claim 5, Brown teaches the method according to claim 1, wherein the

policy information specifies dynamic criteria (Paragraph 94).

Regarding claim 6, Brown teaches the method according to claim 1, wherein the

policy information specifies a combination of static and dynamic criteria (Paragraph 74-

78; 94).

Regarding claim 7, Brown teaches the method according to claim 3, wherein the

using step further comprises the step of accessing a repository, using an identifier of the

IM sender found in the arriving instant message, to determine whether the

characteristics are met for this IM sender. (Paragraph 76)

Regarding claim 8, Brown teaches the method according to claim 1, wherein the response is to open a new IM window for the arriving instant message (Figure 12, elements 162, 9).

Regarding claim 9, Brown teaches the method according to claim 1, wherein the policy information is specified as a set of rules containing the criteria for opening a new IM window for incoming instant messages and wherein the programmatically determined response is to open a new IM window for the arriving instant message (Paragraph 80).

Regarding claim 10, Brown teaches the method according to claim 9, wherein the rules further specify one or more attributes of the IM window to be opened (Paragraph 80).

Regarding claim 11, Brown teaches the method according to claim 8, wherein the policy further specifies one or more attributes of the IM window to be opened (Paragraph 80).

Regarding claim 12, Brown teaches the method according to claim 10, wherein one of the attributes comprises whether the IM window to be opened is to be opened in a minimized state (Figure 12, elements 162, 5, and 4).

Regarding claim 13, Brown teaches the method according to claim 10, wherein the attributes of the IM window to be opened include whether the window flashes when rendered (Paragraph 109).

Regarding claim 14, Brown teaches the method according to claim 1, wherein the response is to generate an audible indicator to signal the arrival of the instant message (Figure 12, elements 162 and 10).

Regarding claims 15 and 22, Brown teaches the method according to claim 14, wherein the audible indicator is generated only if the policy indicates that a new IM window is not to be opened for displaying the arriving instant message (Figure 12, element 166).

Regarding claim 16, Brown teaches the method according to claim 1, wherein the policy information is specified as a set of rules containing the criteria for opening a new IM window for incoming instant messages and wherein the programmatically determined response is to display an indicator of the arriving instant message in a particular IM window that provides a visual indicator of availability of one or more instant messages (Figure 15, elements 190, 192, 194, and 196).

Regarding claim 17, Brown teaches the method according to claim 16, wherein the IM user can selectively view, from the particular IM window, any of the one or more instant messages (Figure 15, elements 190, 192, 194, and 196).

Regarding claim 19, Brown teaches the method according to claim 1, wherein the policy information identifies specified types of entries that may be scheduled on the IM user's electronic calendar (Paragraph 77; 90).

Regarding claim 21, Brown teaches the method according to claim 20, further comprising the step of providing a visual indicator to the recipient IM user that the

instant message was received when the using step does not open the new IM window

(Paragraph 109).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Brown (2003/0055908) in view of Cartmell (7039949).

Regarding claims 23, Brown teaches a method of controlling proliferation of

instant messaging ("IM") windows (Paragraph 42), comprising steps of: enabling a

plurality of IM users to define criteria under which new IM windows should be opened

responsive to receiving an instant message from message senders with whom an IM

session is not already established (Paragraph 55); using the defined criteria to

determine, for at least one of the IM users, whether a new IM window should be

opened; (Paragraph 60; 67).

Brown does not explicitly indicate charging a fee for operation of either or both of

the enabling and using steps.

Cartmell teaches a system of checking policy before sending messages to a user

(Abstract), which includes instant messaging (Column 3, lines 34 – 35). Cartmell

teaches a step of charging a fee for some of the services (Column 10, lines 7 – 9).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to use Cartmell's teaching of using ads or fee's in Brown's policy

based system subsidize costs of the service and to provide revenue support.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Brown in view of Horvitz (2003/0046421).

Regarding claim 18, Brown teaches the method according to claim 1.

Brown does not explicitly indicate wherein the policy information identifies a list of

selected applications that may be active on a computing device of the IM user.

Horvitz teaches a system with policy information on determining whether to

forward new communications to a user (Abstract) which includes monitoring the user's

application usage (Figure 35) plus other user interaction with the computer (Paragraph

263-265).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to use Horvitz's teaching of monitoring a user's activity level and

application usage in Brown's system in order to create a greater understanding of the

availability of the user and use that information to determine whether and how to

forward messages to the user.

Prior Art

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

U. S. Patent No. 6185603 issued to Henderson, because it teaches using policy information to determine whether to alert a user of an incoming message.

U. S. Patent No. 6640230 issued to Alexander, because it teaches using rules to determine how to act on new instant message requests.

U. S. Patent No. 6907447 issued to Cooperman, because it teaches a system for using rules to determine how to display a message window for chat communication.

U. S. Patent No. 2002/0178227 issued to Matsa, because it teaches a system for using policy information to determine how to deliver messages.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Bates whose telephone number is (571) 272-3980. The examiner can normally be reached on 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB

KB
March 5, 2007

SALEH NAJJAR
SUPERVISORY PATENT EXAMINER